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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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9

DATE MAILED: .

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/23/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 3-9 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 3-9 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Applicant's arguments filed October 23, 1995 have been fully considered but they are not deemed to be persuasive.

Claims 1-8 **were** rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Although it is still asserted that "index range" would be better defined as "isocyanate index", applicants' will not be denied their right to define their claims in appropriate alternative form, and rejection is withdrawn. However, upon issuance of allowance it will be necessary that a Statement of Reasons for Allowance contain a statement that this phrase "index range" is understood to equate to "isocyanate index". **If examiner's presumption is wrong, then the record should be clarified before allowance.**

Further, it is assumed by examiner that the phrase "containing urethane groups and predominately isocyanurate groups" is intended to mean "containing urethane groups (in some quantity) and at least 50% isocyanurate groups". Upon issuance of allowance it will be necessary that a Statement of Reasons for Allowance contain a statement that such is the intention of this phrase. **If examiner's presumption is wrong, then the record should be clarified before allowance.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as

Art Unit: 1207

obvious over Volkert ('933) and Volkert et al. ('956) and ('534).

Patentees' disclose processes for the production of rigid foams containing isocyanurate linkages prepared by mixing and reacting polyisocyanates, various 2+ hydroxyl group containing high molecular weight polyols, blowing agents, flameproofing agents, and chain extenders/crosslinkers (see the entire documents). Applicants provide no limiting definition to their branching condition, and it is held that the disclosure of the numerous polyfunctional polyols inherently teaches the condition of branching as defined by applicants' claims. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594. Further, patentees set forth various mixing combinations for their additive agents/reagents.

This rejection is maintained. Applicants do not exclude the further inclusion of vinylfluoroalkanes. Also, it is the entirety of the cited reference which needs to be considered, and burden is upon applicants' to demonstrate distinction over the entirety of the reference. Further, from the standpoint of 35 USC 103, it would have been obvious for one having ordinary skill in the art to have adjusted NCO indices for the purpose of varying amounts of reactants needed in urethane synthesis as implicitly demonstrated by the references variations in their own starting materials and that which is commonly understood in the art. Applicants' showing of criticality is neither seen or demonstrated sufficiently by applicants' pointing to the tables of the specification.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Serial Number: 08-362,547

-4-



Art Unit: 1207

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Correspondence

Any inquiry regarding this or any communication from the examiner should be directed to John Cooney, whose telephone number is (703)-308-2433. **The Examiner is the person to contact to discuss the issues of this application** and can be reached Monday - Friday, 8AM-6PM. The supervisor can be contacted through the receptionist, and general status questions should be referred to the same receptionist at (703) 308-1235. **The FAX phone number for the this ART UNIT is (703)-305-4556 or alternately (703)-305-3592. Formal and Informal** Amendments by FAX are encouraged but should be clearly labelled.

Cooney
1-31-96



JAMES J. SEIDLECK
SUPERVISORY PATENT EXAMINER
GROUP 1200